

### **REMARKS**

The Office Action mailed February 2, 2004 has been carefully reviewed and, in view of the above amendments and following remarks, reconsideration and allowance of the application are respectfully requested.

#### **I. Summary of Claims**

Claims 1-43 are currently pending in the application, with claims 1, 14, 23, 29, and 37 being independent claims. Claims 1, 14, 23, 29, and 37 are amended, in accordance with the above amendments. Claim 24 was previously amended in a Preliminary Amendment.

The following claim rejections were submitted by the Examiner in the outstanding Office Action:

- Claims 1-5, 8-11, 14-15, 19, 21-23, 28-31, 33, 35, and 37-43 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Number 5,260,915 to Houlihan;
- Claims 6-7, 12, 32, and 34 were rejected under 35 U.S.C. §103 as being obvious in light of Houlihan; and
- Claims 13, 16-18, 20, 24-27, and 36 were rejected under 35 U.S.C. §103 as being unpatentable over the combination of U.S. Design Patent Number D466,488 to Wada, et al. and U.S. Patent Number 2,328,785 to Cozart.

#### **II. The Claims Patentably Distinguish Over The Applied Prior Art**

Each of the independent claims recite the features of a timepiece that includes a case and a wristband. In addition, some of the independent claims recite a separating element. The case generally includes a timing element for displaying time, and the wristband is formed integral with the case. Accordingly, the wristband and case are formed as a one-piece element.

Houlihan discloses a wristwatch radiotelephone formed from at least three segments 20a, 20b, and 20c. The segments are joined by pivotable connection mechanisms 30a and 30b, which are essentially hinges, and the two pivotable connection mechanisms "may include a spring for resiliently urging segment members 20a and 20c to pivot relative to segment member 20b" (column 2, lines 41-43). In contrast with each of the independent claims, therefore, Houlihan does not disclose, or otherwise teach or suggest, a configuration wherein the wristband and case are formed as a one-piece element.

In the rejection, the Examiner cites *In Re Troutman* (126 USPQ 56) and states that "whether two elements are integral or separate is of no patentable significance." This broad interpretation regarding the applicability of *Troutman* is inaccurate given that considerations relating to obviousness should be applied in the determination. In fact, more recent decisions have indicated that obviousness is the standard to apply. See, for example, *Carl Schenk, A.G. v. Nortron Corporation*, 713 F.2d 782, 218 U.S.P.Q. 698 (Fed. Cir. 1983).

In *Houlihan*, the "pivotable connections allow the segment members to be disposed relative to one another either in a curved configuration which fits on the wrist when the apparatus is to be worn as a wristwatch, or in a more elongated configuration when the apparatus is to be used as a radiotelephone." Given this express purpose that requires significant flexibility in the wristwatch radiotelephone of *Houlihan*, it would not be obvious to form the case and wristband recited in the independent claims as a one-piece member. In fact, forming the case and wristband as a one-piece member would limit the ability to use the device in *Houlihan* as a radiotelephone. That is, forming the segments of *Houlihan* as a one-piece element would render *Houlihan* inoperable for its intended purpose of elongating when used as a radiotelephone. Various advantages to the claimed invention are also apparent from the one-piece case and wristband configuration, including (1) a lesser number of overall elements in the wristband, (2) reduced manufacturing expenses, and (3) automatic and flexible adjustability to accommodate wrists of various dimensions, for example. Given the detriments to device of *Houlihan* when formed as a one-piece member and the advantages to the claimed invention, the Applicant submits that it would not be obvious to modify *Houlihan* to form the various segments as a one-piece element.

Based upon the above discussion, the Applicant submits that each of independent claims 1, 14, 23, 29, and 37 are allowable over *Houlihan*, and that the various dependent claims rejected over *Houlihan* are allowable for at least the same reason.

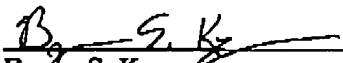
Various claims, which incorporate the limitations of the independent claims discussed above, were rejected as being obvious over the combination of *Wada* and *Cozart*. Neither *Wada* nor *Cozart* teach or suggest forming the case and wristband as a one-piece element. Accordingly, the Applicant submits that claims 13, 16-18, 20, 24-27, and 36 are allowable.

### III. Conclusion

In view of the foregoing, the Applicant respectfully submits that all claims are in a condition for allowance. The Applicant respectfully requests, therefore, that the rejections be withdrawn and that this application now be allowed.

This Amendment is being timely filed by facsimile transmission on April 5, 2004. Should additional fees or an extension of time be deemed necessary for consideration of this Amendment, such fees or extension are hereby requested and the Commissioner is authorized to charge deposit account number 19-0733 for the payment of the requisite fee. If anything further is desirable to place the application in even better form for allowance, the Examiner is respectfully requested to telephone the undersigned representative at (503) 425-6800.

Respectfully submitted,

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